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FROM: Kevin L. Wingate
DATE: May 8, 2006

IN RE APPLN. OF:	Ed VanDyne et al.	***DOCKET NO.***	502972-PCT-US-A
APPL. NO.	10/576,989	***CLIENT NO.***	097264
FILED	April 21, 2006	***MATTER NO.***	1329

Total number of pages sent, including this page 7

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COMMENTS:

PATENT
Attorney Docket No. 502972-PCT-US-A

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Ed VanDyne et al.

Art Unit: Not yet assigned

Application No.: 10/576,989

Examiner: Not yet assigned

Filed: April 21, 2006

For: METHOD AND APPARATUS FOR CONTROLLING EXHAUST GAS RECIRCULATION AND START OF COMBUSTION IN RECIPROCATING COMPRESSION IGNITION ENGINES WITH AN IGNITION SYSTEM WITH IONIZATION MEASUREMENT

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Petition Under 37 CFR 1.182.

On April 21, 2006, four national stage applications having docket numbers 502972-PCT-US-A, 502972-PCT-US-B, 502972-PCT-US-C, and 502972-PCT-US-D were filed in the Receiving Office (RO) of the United States Patent and Trademark Office (USPTO) claiming priority to International Application No. PCT/US2004/35651. The reason for the four applications is that the Applicants believed the claims in the four individual applications would meet unity of invention requirements under the USPTO rules.

On May 1, 2006, the Applicants' representative was contacted by the RO of the USPTO. The RO informed the undersigned that the RO only allows one national stage application per international application. The RO further indicated that the 502792-PCT-US-A application would be assigned serial number 10/576,989 and that a petition should be filed to determine how to proceed with the 502972-PCT-US-B, 502972-PCT-US-C, and 502972-PCT-US-D applications.

Applicants could not find any rule that specifically limits the number of national stage applications to be one national stage application per international application. If for example, the International Searching Authority (ISA) deems a PCT application to lack unity of invention and have two or more inventions, then following the RO's interpretation of the rules, an applicant could only file an application for only

one of the inventions in the PCT application even if the additional search fee was paid. If only one national stage application is allowed, then the second invention that was searched using unity of invention guidelines would not be allowed to be examined under unity of invention guidelines in the U.S., defeating the purpose of paying the additional search fee. This also runs counter to what is allowed in U.S. prosecution where multiple applications can be filed from a single priority application.

A discussion with the USPTO's PCT help desk, which was very helpful, indicated that the rationale behind allowing only one national stage application is based upon the USPTO's interpretation of 35 U.S.C. 363, which states:

> An international application designating the United States shall have the effect, from its international filing date under article 11 of the treaty, of a national application for patent regularly filed in the Patent and Trademark Office except as otherwise provided in section 102(e) of this title.

The PCT help desk indicated that the USPTO is interpreting the phrase "an application" to mean one application. The summary of the bill that was passed into law as Public Law 94-131 is as follows:

> Provides for the implementation of specified provisions of the Patent Cooperation Treaty. Provides that the Patent Office shall act as a Receiving Office for international applications filed by nationals or residents of the United States, and may also act: (1) as a Receiving Office for international applications; and (2) as an International Searching Authority with respect to international applications.
>
> States that a national application shall be entitled to the right of priority based on a prior filed international application which designated at least one country other than the United States. Sets forth the order of priorities as between other applications. Specifies the procedure for withdrawal of international applications and for review of actions of other authorities.
>
> Provides that the filing of an international application in a country other than the United States on the invention made in this country shall be considered to constitute the filing of an application in a foreign country, whether or not the United States is designated in that international application.
>
> Enumerates the items to be filed by the applicant in the Patent Office for commencement of the national stage of processing. **States that all questions of substance and procedure in an international application designating the United States shall be determined as in the case of national applications regularly filed in the Patent Office.**
>
> Provides that the publication under the treaty of an international application shall confer no rights and shall have no effect under this title other than that of a printed publication.
>
> Specifies the fees required and permitted to be charged by the Patent Office. Provides for the allocation of funds appropriated to the Patent Office, to the Department of State for the purpose of payment of the share on the part of the United States to the working capital fund established under the Patent Cooperation Treaty.
>
> Makes conforming amendments to the patent provisions of the United States Code relating to: (1) conditions for patentability; novelty and loss of right to patent; (2) in inventions made abroad; (3) specification of the invention; (4) drawings; benefits of earlier filing dates in the U.S.; and (5) presumption of validity; defenses.
> (emphasis added)

In re Application of: Ed VanDyne et al.
Application No.: 10/576,989

It is respectfully submitted that the statement in the legislative history that "all questions of substance and procedure in an international application designating the United States shall be determined as in the case of national applications regularly filed in the Patent Office" does not indicate that there can only be one national stage application per international application. It is respectfully submitted that this statement indicates that Congress intended that questions of substance and procedure shall be determined as in the case of national applications regularly filed. There is presently no limitation on the number of patent applications that can be filed claiming priority from another application. There therefore should be no limitation on the number of national stage applications claiming priority from an international application.

The Applicants therefore have respectfully filed this petition to determine how to proceed with the 502972-PCT-US-B, 502972-PCT-US-C, and 502972-PCT-US-D filings. If only one national stage application can be filed claiming priority to an international application, the Applicants respectfully request that the 502972-PCT-US-B, 502972-PCT-US-C, and 502972-PCT-US-D filings be converted to be continuations under 35 U.S.C. 1.111(a) of the International Application number PCT/US2004/35651 pursuant to M.P.E.P. section 1895 and apply the filing fees of the 502972-PCT-US-B, 502972-PCT-US-C, and 502972-PCT-US-D filings to the continuations, or alternatively, to be continuations of serial number 10/576,989.

Method of Payment of Fees

☒ Charge Deposit Account No. 50-3505 in the amount of $400.00. (A duplicate copy of this communication is provided for that purpose.)

Authorization to Additional Charge Fees

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Instructions as to Overpayment

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Respectfully submitted,

By Kevin L. Wingate
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CERTIFICATE OF MAILING OR TRANSMISSION UNDER 37 CFR 1.8			
I hereby certify that this Petition Under 37 CFR 1.182 and all accompanying documents are, on the date indicated below are being facsimile transmitted to the U.S. Patent and Trademark Office, Attention: Donna Greene, Facsimile Number 703-308-4785.			
Name (Print/Type)	Danielle Pastuska		
Signature	Danielle Pastuska	*Date*	May 8, 2006